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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/809,062

03/24/2004

Peter Baumann

2848-68-1

8691

22442

7590

06/15/2006

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EXAMINER

MYERS, CARLA J

ART UNIT

PAPER NUMBER

1634

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/809,062	<b>Applicant(s)</b> BAUMANN ET AL.	
	<b>Examiner</b> Carla Myers	<b>Art Unit</b> 1634	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-23 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

***Election/Restrictions***

1. Claims 14-18, 20 and 21 are subject to a restriction since these claims are not considered to recite a proper genus/Markush group.

Specifically, claims 14-18 claim distinct polypeptide sequences comprising the amino acid sequences of SEQ ID NO: 5, 13, 15 and 17. Each of these polypeptides consists of a distinct amino acid sequence, has a different isoelectric point, and a different molecular weight. Additionally, each peptide binds with a different specificity to a different ligand and has a different activity and effect. Given the differences in structure and function, the Markush group set forth in claims 14-18 is not considered to constitute a proper genus, and therefore is subject to a further restriction requirement. A sequence search and non-patent literature search of these sequences would not be co-extensive with one another. For example, a search for SEQ ID NO: 5 would not be coextensive with a search of SEQ ID NO: 13. Further, a reference which renders obvious or non-novel a polypeptide sequence of SEQ ID NO: 5 would not also necessarily render obvious or non-novel a polypeptide sequence of SEQ ID NO: 13. Similarly, a finding that the polypeptide sequence of SEQ ID NO: 5 is novel and unobvious over the prior art would not necessarily extend to a finding that the polypeptide sequence of SEQ ID NO: 13 is also novel and unobvious over the prior art. Accordingly, a search of more than one of the sequences as claimed in claims 14-18 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and the corresponding examination of more than one of the

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claimed sequences. Therefore, Applicants are required to elect one (1) sequence from the sequences of SEQ ID NO: 5, 13, 15 and 17. Note that this is not a species election.

Regarding claims 20 and 21, these claims recite distinct polynucleotide sequences to which the Pot1 polypeptide may bind. Specifically, claims 20 and 21 are inclusive of single stranded telomeric DNAs comprising a sequence selected from the group consisting of SEQ ID NO: 20, and 36-38. Each of these telomeric DNAs consists of a distinct nucleotide sequence, has a different melting point, and binds to a different nucleic acid sequence, and thereby has a different biological function. Given the differences in structure and function, the Markush group set forth in claims 20 and 21 is not considered to constitute a proper genus, and therefore is subject to a further restriction requirement. A sequence search and non-patent literature search of these sequences would not be co-extensive with one another. For example, a search for the nucleic acid sequence of SEQ ID NO: 36 would not be coextensive with a search of the nucleic acid sequence of SEQ ID NO: 37. Further, a reference which renders obvious or non-novel a nucleic acid sequence of SEQ ID NO: 36 would not also necessarily render obvious or non-novel a nucleic acid sequence of SEQ ID NO: 37. Similarly, a finding that the nucleic acid sequence of SEQ ID NO: 36 is novel and unobvious over the prior art would not necessarily extend to a finding that the nucleic acid sequence of SEQ ID NO: 37 is also novel and unobvious over the prior art. Accordingly, a search of more than one of the sequences as claimed in claims 20 and 21 presents an undue burden on the Patent and Trademark Office due to the complex nature of the search and the corresponding examination of more than one of the claimed sequences. Therefore,

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Applicants are required to elect one of the sequences selected from the group consisting of SEQ ID NO: 20, and 36-38. Note that this is not a species election.

Claims 1-13, 19, 22 and 23 link the individual polypeptide and nucleic acid sequences of claims 14-18 and 20-21, respectively, each sequence comprising a distinct invention as outlined above. The restriction requirement between the linked inventions is subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.0

In response to this Office action, Applicant should elect both:

- a) one polypeptide sequence selected from the sequences of SEQ ID NO: 5, 13, 15 and 17; and
- b) one nucleic acid sequence selected from the sequences of SEQ ID NO: 20, and 36-38.

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2. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

3. Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carla Myers whose telephone number is (571) 272-0747. The examiner can normally be reached on Monday-Thursday from 6:30 AM-5:00

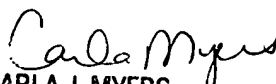
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PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)-272-0735.

The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866)-217-9197 (toll-free).

Carla Myers  
June 12, 2006

  
CARLA J. MYERS  
PRIMARY EXAMINER